

09/587,204

MS147672.1

REMARKS

Claims 1-39 are currently pending in the subject application and are presently under consideration. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein.

I. Rejection of Claim 1 Under 35 U.S.C. §112, First Paragraph

Claim 1 stands rejected under 35 U.S.C. 112, first paragraph, for including subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In particular, it was asserted in the Final Office Action (dated December 12, 2003) that it is unclear whether the "stored configuration" is located in the first or second computer systems and the Examiner requested that applicants point out exactly where this limitation is discussed in the specification. (See Final Office Action, p.2).

In the Reply to the Final Office Action, applicants' representative submitted that such limitations can be found at page 7, lines 24-29 and in connection with figures 1, 2, 3, 4a and 6 (configurations 52, 52a and 52b) of the subject application. Accordingly, this rejection should be withdrawn.

In addition, in the Reply to the Final Office Action applicants' representative submitted a proposed amendment to claim 1 in order to clarify that the stored configuration, as recited in the subject claim, is associated with the first computer. However, this amendment has not been entered. The Examiner contends that this amendment raises new issues that would require further consideration. Applicants' representative respectfully submits that this rejection should be withdrawn, absent the proposed amendment, for the reasons stated in the preceding paragraph.

II. Rejection of Claims 1-6, 14-18, 22-34, and 38 Under 35 U.S.C. §102(b)

Claims 1-6, 14-18, 22-34, 37 and 38 stand rejected under 35 U.S.C. §102(b) as being anticipated by Cheston, *et al.* (U.S. 6,412,025). It is respectfully submitted that this rejection should be withdrawn for at least the following reason. Cheston, *et al.* does not teach or suggest each and every aspect recited in the subject claims.

09/587,204

MS147672.1

A single prior art reference anticipates a patent claim only if it expressly or inherently describes each and every limitation set forth in the patent claim. *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 U.S.P.Q.2d 1597 (Fed. Cir. 2002). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claim 1

Independent claim 1 recites a first computer that configures a network interface based on *modifying* at least one stored configuration associated with received network information. Cheston, *et al.* does not describe such claimed aspects. Instead, Cheston, *et al.* discloses assigning a *previous* or *new IP address* upon attaching to a network. In particular, Cheston, *et al.* discloses that a *previous IP address* is utilized upon re-attaching to an entry point of a network or a *new IP address* is obtained when a new connection (*e.g.*, connecting to a different entry point) is established with the network. (See Abstract; col.4, ll.10-16; and col.6, ll.38-52 (Fig. 4)). As disclosed in detail in Cheston, *et al.*, a log is employed and updated with IP addresses such that the log provides a history of previously and currently employed IP addresses, which can be utilized upon re-attaching to the network. (See col.7, ll.4-14). In addition, new IP addresses can be obtained from DHCP when attaching to a new entry point. (See col.3, l.62 – col.4, l.29)

In contrast, the subject claim recites *modifying* at least one stored configuration associated with received network information in order to facilitate configuring a network interface. As disclosed in the subject application, a first computer (computer 20) can store network configurations and utilize the stored network configurations to set up the network interface. (See Application, p.7, ll.25-28). In instances where a stored configuration does not directly relate to received network information (See Application, p.10, ll.9-12), the first computer can employ *modifications of stored configurations* to facilitate determining a suitable network configuration (See Application, p.10, ll.17-18). Cheston, *et al.* is silent regarding such novel features.

09/587,204

MS147672.1

In the Final Office Action, the Examiner contended Cheston, *et al.* discloses utilizing a modified stored configuration, as recited in the subject claim. The Examiner referenced column 5, lines 25-33 of Cheston, *et al.* to support this contention and stated, "Cheston teaches a stored table of terminals attached to the server (interpreted as a second computer system) that is updated when a terminal is removed. In this case, the 'updated' information is interpreted as 'modified' stored configuration." (See Final Office Action, p.15). From this quotation, it is readily apparent that Cheston, *et al.* discloses a server-side table that can be utilized to identify *terminals* attached to the server. (See Cheston, *et al.*, col.5, ll. 20-21). However, the section of Cheston, *et al.* does *not* disclose storing network configuration, as recited in claim 1.

Moreover, the Examiner stated that he "interprets" *updating* this table of stored terminals to be synonymous with *modifying* stored network configurations, as recited in the subject claim. (See Final Office Action, p.15). However, Cheston, *et al.* defines updating the server-side table of terminals as *removing* pointers from the server-side table that are associated with a terminal no longer connected to a node (an old location) since such pointers are no longer valid and *adding* terminal information to the server-side table of terminals when attaching the terminal to a new node in order to indicate the new location. The foregoing is utilized when a terminal is moved so that data is not misdirected to a removed terminal. (See Cheston, *et al.*, col.5, ll. 25-33). However, Cheston, *et al.* does *not* teach or suggest *modifying* stored network configurations as recited in claim 1.

The Examiner further referenced Cheston, *et al.*, col.3-4, ll.62-29 and figure 4 to support this contention. However, this section of Cheston, *et al.* simply discloses a system that "seeks" an IP address when it needs one, which does *not* teach or suggest configuring a network interface based on *modifying* at least one *stored configuration*, as recited in the subject claim.

Claim 17

Independent claim 17 recites a delay timer with a delay time *based on a value of an associated address*. Cheston, *et al.* does not teach or suggest a delay timer or a delay time based on a value of an address. In the Final Office Action, the Examiner argued that delay timers are inherent in systems that query networks. However, the Examiner does not provide any support for delay times *based on a value of an associated address*, as recited in the subject claim. "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical

09/587,204

MS147672.1

reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." See MPEP §2112 quoting *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Since the Examiner does *not* address basing delay time on *a value of an associated address*, it is submitted that he has not provided a sufficient basis in fact and/or technical reasoning to reasonably support an inherency assertion based on the teachings of *Cheston, et al.*

Claim 24

Claim 24 recites means for configuring a network interface before a network identification has been established based upon the response from a network. As disclosed in the subject specification, at least one means includes a first computer configuring a network interface based on modifying a stored configuration associated with received network information. As discussed *supra*, *Cheston, et al.* does not describe such novel aspects.

Claim 26

Independent claim 26 recites a system comprising a multiple internet protocol configurations (MIPC) service that matches the at least one network configuration stored within the first computer with a network identification associated with the information received from the second computer, wherein the match facilitates the first computer in configuring a network interface. *Cheston, et al.* does not teach or suggest such features. Rather, *Cheston, et al.* simply discloses employing DHCP to provide an IP address in response to a request from a terminal. (See col. 3, lines 62-67).

In the Final Office Action, the Examiner concluded that a terminal's identification "must" be matched to IP addresses stored in the DHCP since *Cheston, et al.* does not seek a new IP address when a new IP address is not required. (See Final Office Action, p.16, Response to Arguments). However, the subject claim does not recite *requesting* an IP address from a DHCP or *receiving* an address therefrom. Instead, claim 26 recites matching network configuration stored within the first computer with a network identification associated with received network information. *Cheston, et al.* does not teach or suggest these claimed aspects; thus, *Cheston, et al.* does not teach each and every element of claim 26.

09/587,204

MS147672.1

Claim 34

Independent claim 34 recites the third computer system that determines a network configuration *via* communications from at least one of a first computer system and a second computer system. As disclosed in the subject application, the third computer system (other computers) can listen to network communications, for example, from the first computer system and/or the second computer system, and utilize this information to determine network configuration. (*See* Application, p.8, ll.7-14). Cheston, *et al.* does not teach or suggest such claimed aspects.

In the Final Office Action, it is contended that Cheston, *et al.* discloses such a system and references figure 3 to support this contention. However, this section is silent regarding such aspects. In particular, the referenced section of Cheston, *et al.* simply provides an example of a typical network, wherein various computers are attached to one of a plurality of servers/routers, the servers/routers in turn are coupled to a host and a network. However, the referenced section of Cheston, *et al.* does not contemplate determining third computer system network configuration from at least one of a first computer system and a second computer system, as recited in the subject claims.

In view of the foregoing comments, it is respectfully requested that the rejection of independent claims 1, 17, 24, 26 and 34 (and claims 2-6 and 14-16, 18 and 22-23, 25, 27-33, and 38, which respectively depend therefrom) be withdrawn.

III. Rejection of Claims 7-11, 35 and 39 Under 35 U.S.C. §103(a)

Claims 7-11, 35 and 39 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Cheston, *et al.* (U.S. 6,412,025) in view of LeMaire, *et al.* (U.S. 5,999,530). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. The combination of Cheston, *et al.* and LeMaire, *et al.* does not teach or suggest *all* claim limitations as recited in the subject claims.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness by a showing: there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine

09/587,204

MS147672.1

reference teachings; there must be a reasonable expectation of success, and the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP §706.02(j).

Claims 7-11, 35 and 39 depend from independent claims 1 and 34, respectively, and LeMaire, *et al.* fails to make up for the aforementioned deficiencies of Cheston, *et al.* with respect to independent claims 1 and 34. LeMaire, *et al.* simply discloses a bridge that reduces unwanted WAN multicast packet traffic in a LAN *via* employing a filter based on information stored in a filtering database from WAN query and report packets and router-to-router packets. Accordingly, withdrawal of this rejection is requested.

IV. Rejection of Claims 12-13, 19-21 and 36 Under 35 U.S.C. §103(a)

Claims 12-13, 19-21 and 36 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Cheston, *et al.* (U.S. 6,412,025) in view of Romohr (U.S. 5,596,723). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Cheston, *et al.* and Romohr, individually or in combination, do not teach or suggest *all* claim limitations as recited in the subject claims.

Claims 12-13, 19-21 and 36 depend from independent claims 1, 17 and 34, respectively, and Romohr does not make up for the aforementioned deficiencies of Cheston, *et al.* with respect to independent claims 1, 17 and 34 (described *supra*). Instead, Romohr discloses a system that determines the most prevalent operating system services and protocols of a network and then configures itself accordingly. Since the combination of Cheston, *et al.* and Romohr does not teach or suggest *all* the limitations of the subject claims, it is respectfully requested that the rejection of claims 12-13, 19-21 and 36 be withdrawn.

09/587,204

MS147672.1

Conclusion

The present application is believed to be condition for allowance in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

AMIN & TUROCY, LLP



Himanshu S. Amin
Reg. No. 40,894

AMIN & TUROCY, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114

Telephone (216) 696-8730
Facsimile (216) 696-8731